

ONS00515

REMARKS

Claims 1-17 remain in the application.

Applicants respectfully submit that the Restriction is improper at least because claims 1-17 are directed to a product, a method of making a product, and a method of using the product to make a semiconductor package. Consequently, a restriction is proper ONLY if a three way restriction can be made. Such three way restriction requires that one of the three categories be unpatentable.

Applicants respectfully submit that all three categories of claims 1-17 are patentable. Accordingly, the requirement for restriction in the present case is improper and should be withdrawn.

The Office Action states that a restriction is required under 35 U.S.C. 121 to claims 1-11 (Group I), or claims 12-17 (Group II).

The requirement for restriction that has been made in the present application is traversed. It appears that the restriction requirement is stating that the inventions of Group I and Group II are distinct from each other because they are related as process of making and product made, and the structure of Group I is distinct from the process of Group II because the structure of the Group I invention can be made by processes materially different than those of the Group II invention. For example, the leadframe may be formed by eliminating the encapsulation process. First, the encapsulation step of claims 1-11 is one element of a method of making a semiconductor package and it is preferable to encapsulate a semiconductor package. Thus a materially different process of forming a either semiconductor package has not been identified.

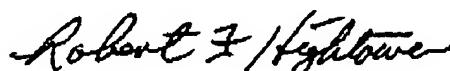
ONS00515

Additionally, it is noted that restriction is never mandatory and is discretionary under 35 U.S.C. 121 only when "two or more independent and distinct" inventions are claimed. The Office Action alleges that restriction is required because the invention of applicant's claims is "distinct". It has not been alleged that applicant's claimed inventions are "independent and distinct", and yet this requirement is a prerequisite under the Patent Statutes before the Commissioner's discretion may be exercised under 35 U.S.C. 121.

Thus, it is respectfully submitted that the restriction requirement should be removed because there is not a valid ground under 35 U.S.C. 121 for exercising the Commissioner's discretion and requiring the restriction.

The provisional election of the Group I claims, i.e. claims 1-11, is hereby confirmed. The restriction requirement is traversed, however, and reconsideration and withdrawal of the requirement for restriction is respectfully requested.

Respectfully submitted,
Joseph K. Fauty, et al.



ON Semiconductor
Law Dept./MD A700
P.O. Box 62890
Phoenix, AZ 85082-2890

Robert F. Hightower
Attorney for Applicant(s)
Reg. No. 36163
Tel. (602) 244-5603

Customer #: 27255